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TTAB

ALONSO

May 14, 2009

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

Re: *Petition For Cancellation Filed Against Trademark Registration No. 3,170,684*
For the Mark: Alacranes Musical
Petitioner: Oscar Urbina, Jr.
Respondent: Aguila Records, Inc.

7E/589, 171

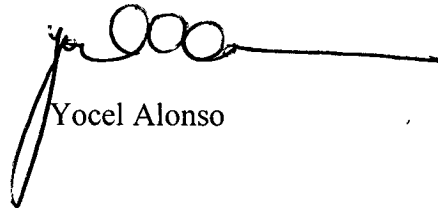
Dear Sir or Madam:

Enclosed for filing are the following documents filed on behalf of Petitioner, Oscar Urbina, Jr.:

1. Petition For Cancellation and Certificate of Service; and
2. A check in the amount of \$300.00.

If you have any questions on the above or any aspect of this matter, please do not hesitate to contact me. Thank you for your assistance.

Respectfully Submitted,


Yocel Alonso

Enclosures

cc: Richard J. Gurak



05-14-2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

OSCAR URBINA, JR.

Petitioner

v.

AGUILA RECORDS, INC.

Respondent

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CANCELLATION NO. _____

REGISTRATION NO. 3,170,684

MARK: ALACRANES MUSICAL

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

PETITION FOR CANCELLATION

1. Oscar Urbina, Jr. ("Urbina" or "Petitioner") is an individual residing at 656 Sumac Drive, Aurora, Illinois 60506. Urbina is an original member and owner of the musical group known as the "Alacranes Musical" and one of the truthful owners of the "Alacranes Musical" trademark. Petitioner's date of first use is June 17, 1995. In 1999, Petitioner first began making musical recordings under that trademark. Attached hereto as Exhibit "A" and incorporated herein by reference for all purposes is a true and correct copy of Petitioner's first prerecorded audio compact disk, containing music of the Durango genre, which was recorded and distributed for sale to the public in the United States under the "Alacranes Musical" trademark.

2. Aguila Records, Inc. ("Aguila" or "Respondent") is listed as the owner of Registration No. 3,170,684 for the mark "Alacranes Musical" for "prerecorded compact disks, audio and video disks and cassettes, all featuring Spanish language musical recordings of the Durango genre, in Class 9."

Respondent is not the owner of the trademark but was allowed to use the mark by Petitioner in connection with the sale of musical recordings pursuant to a written contract dated September 9, 2003(the "Artist's Contract").

3. Upon information and belief, Respondent is located at 245 Roosevelt Road, West Chicago, Illinois, 60185.

4. Commencing in 1999 and long prior to Respondent's claimed date of first use, Petitioner had been and still is engaged in the sale, advertising, and promotion of prerecorded compact disks, audio and video disks and cassettes featuring Spanish language musical recordings of the Durango genre covered under Class 9. In fact, the earliest Specimens submitted by Respondent in support of its application for registration are of two compact disks attached as Specimens to Respondent's April 21, 2006 Response to Office Action which were not recorded, manufactured, or distributed by Respondent, but were recorded by Petitioner and originally distributed by Terrazas Records, Inc. by agreement with Petitioner before Respondent's claimed date of first use.

5. As a result of Petitioner's promotion and use of Petitioner's "Alacranes Musical" mark, customers have come to know and recognize Petitioner's mark and have associated same with Petitioner's goods and services.

6. Respondent has not used the mark "Alacranes Musical" to the exclusion of others. On the

contrary, Respondent obtained the permission of the Petitioner for use the mark under the Artist's Contract and as the Petitioner's agent. Respondent is now falsely claiming ownership and obtained the registration of the trademark by breaching his fiduciary duties owed to Petitioner. Respondent also has unclean hands and is estopped from claiming ownership of the trademark. Petitioner has made substantial and continuous used the mark "Alacranes Musical" long before Respondent's alleged date of first use in interstate commerce in connection with the recording and distribution of audio and video pre-recorded compact disks and cassettes containing music of the Durango genre and is entitled to cancellation of the trademark because of Respondent's wrongful and inequitable conduct.

7. Respondents' use and registration of the mark "Alacranes Musical" will enable Respondent to trade upon and utilize the goodwill established by Petitioner in Petitioner's mark.

8. Respondent's use and registration of the mark "Alacranes Musical" is a simulation and/or a colorable imitation Petitioner's mark.

9. Petitioner and Respondent are both engaged in the sale and promotion of their respective goods through the same channels of trade, and to the same general class of purchasers.

10. Upon information and belief, the publish and/or consumers are likely to be confused, mistaken, or deceived as to the origin and sponsorship of Respondent's goods marketed under the mark "Alacranes Musical" and/or misled into believing that such goods emanate from, are licensed by, or

are in some way directly or indirectly associated with Petitioner, or are the goods of Petitioner.

11. Petitioner will be damaged by the continued use and registration by Respondent of the mark "Alacranes Musical" as set forth in Respondent's Registration No. 3,170,684 because a) Respondent's alleged mark is confusingly similar to Petitioner's "Alacranes Musical" mark for said goods; and b) such continued use and registration would support and assist Respondent in the confusing, misleading, and deceptive use of Petitioner's mark and would give to Respondent color of exclusive statutory rights to such designation in violation of Petitioner's superior rights.

12. Respondent fraudulently misrepresented itself as the owner of the "Alacranes Musical" mark when it only had a right to use the mark from Petitioner for a limited purpose. It also committed fraud on the United States Patent and Trademark Office by:

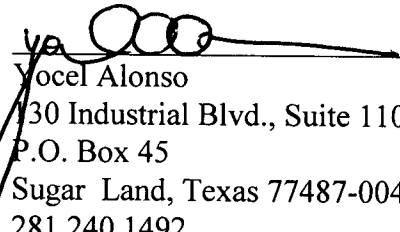
a) misrepresenting its date of first use as "at least as early as 12/31/2001;" and

b) submitting false specimens of use, such as copies of recordings shown in support of its application that do not belong to Respondent, but in fact were pictures of CD covers of recordings made by Petitioners for Terrazas Records, Inc. and/or other record companies, pre-dating the Respondent's claimed date of first use in its application for registration.

WHEREFORE, Petitioner prays that this Petition for Cancellation be granted and that Registration No. 3,170,684 be CANCELLED.

The filing fee for this Petition to Cancel in the amount of \$300.00 is enclosed herewith.

Respectfully Submitted,


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281.240.1492
Fax: 713.583.0721
Email: yocelaw@aol.com

Attorney for Petitioner Oscar Urbina, Jr.

Date: May 14, 2009

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Petition For Cancellation has been served in compliance with 37 CFR §2.111 on this 14th day of May 2009 to the following:

Aguila Records, Inc.
c/o: Richard J. Gurak, Esq.
Welsh & Katz, Ltd.
120 S. Riverside Plaza, 22nd Floor
Chicago, Illinois 60606


Yocel Alonso

Alacranes Musical



De Emiliano Martinez, Durango

Alacranes Musical

De Emiliano Martinez, Durango

1999 All Rights Reserved

Terrazas
RECORDS

1. Chaparrita De Mi Vida
2. La Parra
3. Tu Delirio
4. El Borrego
5. Valentin De La Sierra
6. Pa Que Son Pasiones
7. La Verde
8. La Cachetona
9. Los 2 Amigos
10. Arriba El Taconazo

Dedicado:

A nuestras familias, amigos, seguidores de nuestra musica y toda la gente que nos ha apoyado a lo largo de nuestra carrera. Para toda la gente del Edo de Dgo. En especial para Santa Maria del Oro, Escobedo, Galeana, El Quemado, Celestino, Santa Rosa, La Tinaja, Las Taunas, Ramos, La Galera, Emiliano Martínez y todo Santiago Papasquicero.

Chaparrita De Mi Vida
(D.A.R.) Ranchera

La Parra
(D.A.R.) Polka

Tu Delirio
(D.A.R.) Ranchera

El Borrego
(Jose A. Jimenez) Corrido

Valentin De La Sierra
(Luis Perez Meza) Corrido Inst.

ALACRANES



MUSICAL

Gracias:

A Jose Luis Terrazas de Terrazas Records por su apoyo y confianza. A nuestros padres por su bendicion y a ustedes por escucharnos. — Alacranes Musical

Integrantes:

Joel Urbina - Voz
Oscar Urbina - Sax
Oscar Urbina Jr. - Sax y Teclados
Eduardo Urbina - Teclados
Martin Salcedo - Bass
Rene Urbina - Bateria

Para Contrataciones:
Oscar Urbina 630-896-9050

Pa Que Son Pasiones
(D.A.R.) Ranchera

La Verde
(D.A.R.) Polka

La Cachetona
(D.A.R.) Polka

Los 2 Amigos
(D.A.R.) Corrido

Arriba El Taconazo
(D.A.R.) Polka

Terrazas Records
Office 630-616-8165
Pager 630-270-7641

Alacranes Musical
De Emiliano Martinez, Durango

Alacranes Musical
De Emiliano Martinez, Durango

Alacranes Musical

De Emiliano Martinez, Durango



1. Chaparrita De Mi Vida 2. La Parra 3. Tu Delirio
4. El Borrego 5. Valentin De La Sierra
6. Pa Que Son Pasiones 7. La Verde 8. La Cachetona
9. Los 2 Amigos 10. Arriba El Taconazo



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